

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

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U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROGER MINKOW, LANCE J. BOHLEN and ROGER F. EGGER

Appeal No. 2005-1541
Application No. 09/878,719

HEARD: NOVEMBER 16, 2005

Before McQUADE, NASE and BAHR, Administrative Patent Judges.
McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Roger Minkow et al. appeal from the final rejection (mailed June 4, 2002) of claims 25 and 26, the only claims pending in the application.

THE INVENTION

The invention relates to "bicycle seats, and more specifically, to anatomically correct support provided by a seat" (specification, page 1). Claims 25 and 26 read as follows:

25. An ergonomic bicycle saddle, comprising:

a rigid frame defining a front end, a back end, a front half, a back half, a first outer side and a second outer side, said frame defining a first support surface at said front end of said saddle extending from said first outer side to said second outer side and generally widening from front to back;

a resilient padding layer disposed on top of said frame and having a front end, a back end, a front half, a back half, a first outer side and a second outer side, said padding layer being continuous from said first outer side to said second outer side at said front end of said padding layer, and defining an upper surface;

a central groove at least partially defined by inwardly facing sides of said resilient material which are beveled outward toward said upper surface, said groove extending to form a scrotum channel positioned roughly in the longitudinal center of said saddle, said groove having a leading edge defined by said resilient material, said groove narrowing as said groove extends toward said scrotum channel along a longitudinal axis from approximately said back end of said frame; and

said leading edge of said groove extending forward to about midway through said front half of said padding layer; and

wherein said groove provides an open space for relieving pressure on the pudendal arteries.

26. An ergonomic bicycle seat, comprising:

a rigid frame defining a front end, a back end, a front half, a back half, a first outer side and a second outer side, said frame defining a first support surface at said front end of said seat extending from said first outer side to said second outer side and generally widening from front to back;

a resilient padding layer disposed on top of said frame and having a front end, a back end, a front half, a back half, a first outer side and a second outer side, said padding layer being continuous from said first outer side to said second outer side at said front end of said padding layer, and defining an upper surface;

a central groove at least partially defined by inwardly facing sides of said resilient material which are beveled outward toward said upper surface, said groove extending to form a scrotum channel positioned roughly in the longitudinal center of said seat, said groove having a leading edged defined by said resilient material, said groove narrowing as said groove extends toward said scrotum channel along a longitudinal axis from approximately said back end of said frame; and

wherein said groove is approximately one inch wide at a location midway between said front end and said back end of said frame.

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THE EVIDENCE

The items relied on by the examiner as evidence of anticipation and obviousness are:

Henderson 576,310 Feb. 02, 1897

ISCA Components product brochure, "Plus" item (undated)¹

The item relied on by the appellants as evidence of novelty and non-obviousness is:

The 37 CFR § 1.132 Declaration of Dr. Roger D. Minkow filed November 15, 2002.

THE REJECTIONS

Claim 25 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Henderson.

Claim 26 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Henderson.

Claim 25 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Plus.

Claim 26 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Plus.

¹ The appellants submitted this reference with an information disclosure statement filed January 29, 2002. They do not dispute that it is prior art relative to the subject matter on appeal under 35 U.S.C. § 102(b).

Attention is directed to the main and reply briefs (filed February 10, 2003 and July 14, 2003) and answer (mailed May 6, 2003) for the respective positions of the appellants and examiner regarding the merits of these rejections.²

DISCUSSION

I. The 35 U.S.C. § 102(b) rejection of claim 25 as being anticipated by Henderson

Henderson discloses a bicycle saddle comprising a framework and a cushion. The framework includes a wire configured to form the general outline of the saddle, a brace plate attached to the rear of the wire and a perforated wood seat disposed on the brace plate (see Figures 4-7). The cushion consists of a cloth cover and two soft interior cushions B and C arranged to define a longitudinal depression in the upper surface of the saddle (see Figures 1-3).

Anticipation is established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention. RCA Corp. v.

² In the final rejection, the examiner included U.S. Patent No. 594,451 to Wheeler in the statements of the § 103(a) rejections of claim 26. The accompanying explanations of the rejections indicate, however, that the inclusion of Wheeler was inadvertent. The examiner has confirmed as much in the answer (see page 2).

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Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). In other words, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. Scripps Clinic & Research Found. v. Genentech Inc., 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991).

As indicated above, claim 25 recites an ergonomic bicycle saddle comprising, inter alia, a rigid frame defining a first support surface at the front end of the saddle extending from the first outer side of the frame to the second outer side of the frame and generally widening from front to back. The examiner submits that these limitations are met by the front of Henderson's framework wire "which forms a first support surface (the top surface of the bent wire), which extends 'perimetricaly' from a first outer side continuously to a second outer side and '**generally**' widens from a front to a back" (answer, page 4). The appellants counter that "the surface provided by the wire of Henderson does not 'generally widen from front to back.' To the contrary, the wire of Henderson has a round cross section . . . which apparently maintains a fairly constant cross-section as it defines the perimeter of the frame" (reply brief, page 4).

The appellants' position here is persuasive. While the front of Henderson's framework wire arguably defines a support surface at the front end of the saddle extending from one outer side to the other outer side of the frame, Figure 4 of the reference clearly shows that such support surface does not generally widen from front to back under any reasonable interpretation of these words. As the Henderson reference does not teach any other structure which meets the claim language in question, it fails to disclose each and every element of the bicycle saddle recited in claim 25.

Accordingly, we shall not sustain the standing 35 U.S.C. § 102(b) rejection of claim 25 as being anticipated by Henderson.

II. The 35 U.S.C. § 103(a) rejection of claim 26 as being unpatentable over Henderson

Claim 26 is similar to claim 25 in that it too recites a rigid frame defining a first support surface at the front end of the saddle extending from the first outer side of the frame to the second outer side of the frame and generally widening from front to back. In addition to not disclosing a bicycle seat having such a feature, Henderson would not have suggested same to one of ordinary skill in the art.

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Henderson also fails to teach or suggest a bicycle seat having a central groove which is "approximately one inch wide" at a location midway between the front and back ends of the frame as recited in claim 26. The appellants' 37 CFR § 1.132 declaration establishes that this feature reduces erectile dysfunction, genital discomfort and undue pressure on the pudendal arteries. Conceding that Henderson does not disclose a central groove having the specified width, the examiner deals with this deficiency by citing In re Rose, 220 F.2d 459, 105 USPQ 237 (CCPA 1955), for the proposition that "[a] change in size is generally recognized as being within the level of ordinary skill in the art" (answer, page 4). Such a mechanical or per se rule of obviousness rests on legal error, however, because it sidesteps the fact specific analysis of claims and prior art required by § 103(a). See In re Ochiai, 71 F.3d 1565, 1571-1572, 37 USPQ2d 1127, 1132-1133 (Fed. Cir. 1995); and In re Wright, 343 F.2d 761, 769, 145 USPQ 182, 190 (CCPA 1965).

Therefore, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of claim 26 as being unpatentable over Henderson.

III. The 35 U.S.C. § 102(b) rejection of claim 25 as being anticipated by Plus

The copy of the Plus reference which is of record in the image file wrapper (IFW) of the instant application is essentially illegible.³ The apparent photograph contained in the reference appears to show a bicycle seat/saddle having a central groove in its upper surface. This showing, however, is too unclear to support a finding that the reference meets the limitations in claim 25 requiring the central groove to have a leading edge which extends forward to about midway through the front half of the padding layer to provide an open space for relieving pressure on the pudendal arteries.⁴ In this regard, it is well established that an anticipation rejection cannot be predicated on an ambiguous reference. In re Turlay, 304 F.2d 893, 899, 134 USPQ 355, 360 (CCPA 1962).

Consequently, we shall not sustain the standing 35 U.S.C. § 102(b) rejection of claim 25 as being unpatentable over Plus.

³ At the oral hearing, the appellants' counsel tendered another copy of the Plus reference. As the quality of the tendered copy is as poor as that of the IFW copy, it has not been accepted for entry into the record.

⁴ The appellants' 37 CFR § 1.132 declaration establishes the medical benefits of this feature.

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IV. The 35 U.S.C. § 103(a) rejection of claim 26 as being unpatentable over Plus

The examiner's rationale for curing the admitted failure of Plus to disclose a groove which is approximately one inch wide at a location midway between the front and back ends of the frame as recited in claim 26 mirrors the rationale advanced in connection with the rejection based on Henderson and fails for the same reasons. Furthermore, and in a more general sense, the Plus reference, due to its considerable ambiguity, does not provide the factual basis necessary to support a conclusion of obviousness with respect to the subject matter recited in claim 26.

Thus, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of claim 26 as being unpatentable over Plus.

V. Remand to the examiner

This application is remanded to the examiner under the authority of 37 CFR § 41.50(a) and MPEP § 1211 for consideration of the following matters.

A review of the appellants' specification does not reveal any apparent support or antecedent basis for the recitation in claim 25 that the leading edge of the groove extends forward to about midway through the front half of the padding layer or for the recitation

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in claim 26 that the groove is approximately one inch wide at a location midway between the front and back ends of the frame.⁵ This circumstance raises questions as to whether the specification complies with the technical requirements of 37 CFR § 1.75(d)(1) and/or the written description requirement of 35 U.S.C. 112, first paragraph.⁶ On remand, the examiner should (1) consider whether the specification complies with the foregoing regulatory and statutory provisions, and (2) enter the appropriate objections and/or rejections if the specification is determined to be deficient in this regard.

⁵ When queried at the oral hearing, the appellants' counsel responded that support for each of these limitations could be found in the application drawings.

⁶ The test for compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventors had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983). The content of the drawings may also be considered in determining compliance with the written description requirement. Id.

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SUMMARY

The decision of the examiner to reject claims 25 and 26 is reversed, and the application is remanded to the examiner for further consideration.

REVERSED AND REMANDED



JOHN P. MCQUADE)
Administrative Patent Judge)
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